REMARKS

Claims 1-3 have been canceled. Accordingly, claims 4-13 are currently pending in the present application.

Reconsideration and allowance based on the following remarks are respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. §102

A. Claims 1-6, 8, 9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,937,391 to Ikeda, et al. ("Ikeda"). Applicant traverses this rejection for at least the following reasons.

Applicant submits that the cited portions of Ikeda fail to disclose, teach, or suggest a virtual mall apparatus comprising *inter alia* "means for discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data; and means for executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops," as recited in claim 4. Claims 8 and 11 recite similar limitations as claim 4, respectively and thus, the analysis below applies equally.

The cited portions of Ikeda merely disclose a point-service system in a virtual shopping mall. In particular, Ikeda discloses how to issue points to consumers and how consumers may redeem the issued points among virtual shops. Ikeda discloses the redemption is merely "to redeem the points for discount, refund or an awarding gift." Col. 1, lines 32-33 of Ikeda; *see also* claim 8 of Ikeda. Applicant submits the "discount" of Ikeda is merely a monetary equivalent proportional to the redeemed points applied towards the cost of the item. The cited portions of Ikeda make no mention or suggestion of "generating a purchased item data ... including... a discount item flag indicating that the purchased item is a discount item, the discount item flag being set where the purchased item is specified as a discount item by one of the plurality of shops." In contrast, the present invention provides purchased item information including a particular discount for each item. *See e.g.,* page 9, lines 4-7 of Applicant's disclosure.

The Office Action asserts that Figure 8 of Ikeda allegedly discloses a discount flag. However, Figure 8 of Ikeda merely discloses a point-management table. None of the parameters of the point-management table are related to "a discount item flag indicating that

the purchased item is a discount item." Indeed, there is simply no parameters in the point-management table shown in Figure 8 of Ikeda relating any purchased item to a discount.

Additionally, the Office Action, asserts that the disclosure at col. 14, lines 36-39 and col. 16, lines 33-37 of Ikeda allegedly disclose the claimed discriminating and executing means. However, none of these cited portions disclose, teach, or suggest "executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops." Again, there is simply no parameters in Ikeda relating any purchased item to a discount, let alone, determining that the items indicated by the at least two discount item flags are purchased from different shops.

Accordingly, Applicant submits that the cited portions of Ikeda do not disclose, teach, or suggest, each and every limitation of claims 4, 8 and 11. Claims 5, 6, 9 and 12 depend from claims 4, 8 and 11 respectively and are, therefore, patentable for at least the same reasons provided above related to claims 4, 8 and 11, and for the additional features recited therein. Claims 1-3 have been canceled and thus their rejection is now moot. Thus, Applicant respectfully requests that the rejection of claims 4-6, 8, 9, 11 and 12 under 35 U.S.C. §102(b) in view of Ikeda should be withdrawn and the claims be allowed.

B. Claims 1-13 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,643,624 to Phillippe, et al. ("Phillippe"). Applicant traverses this rejection for at least the following reasons.

Applicant submits that the cited portions of Phillippe fail to disclose, teach, or suggest a virtual mall apparatus comprising *inter alia* "means for discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data; and means for executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops," as recited in claim 4. Claims 8 and 11 recite similar limitations as claim 4, respectively and thus, the analysis below applies equally.

The cited portions of Phillippe disclose a method for interacting with multiple web sites in order to effect commercial transactions on the web. In particular, Phillippe discloses providing a check-out application to fill in one or many order entry forms for each of the relevant vendors whose goods the user selects during the course of shopping.

Indeed, the cited portions of Phillippe make no mention or suggestion of a discount, let alone, "executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops." *See e.g.*, Figures 2C and 2D of Phillippe (while prices for each item are shown, no item discounts are shown).

The Office Action asserts that the disclosures at col. 12, lines 3-9 and line 13 of Phillippe allegedly disclose the claimed discriminating and executing means. However, these cited portions of Phillippe simply make no mention or suggestion of discounts, and therefore fail to disclose, teach, or suggest "executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops." The cited portions of Phillippe are merely used to fill in the order entry form.

Further, the Office Action asserts "Discount item flags would correspond to attributes (col. 13, line 4) in the order entry form necessary for processing the order." As there is clearly no element related to a discount expressly disclosed in Phillippe, the Examiner must further refer to U.S. Patent Application Serial No. 08/724,943 which issued U.S. Patent No. 5,826,258 ("the '258 patent") and to the information from the Barnes and Noble, Inc.'s Website cited on the PTO-892 ("the reference U"), for allegedly teaching discounts.

Without conceding that this multiple reference anticipation rejection is appropriate, Applicant submits that neither the '258 patent nor the reference U disclose the same apparatus as Phillippe. *See* MPEP § 2131.01 (III). Just because Phillippe makes reference to the '258 patent application and refers to Barnes and Nobles, Inc. in Figure 2C by themselves, do not necessarily establish that the missing descriptive matter of Phillippe is necessarily present in those references. For example, seeking to find an apartment as discussed by the '258 patent is simply unrelated to purchasing products from a virtual store.

Moreover, assuming *arguendo* that the '258 patent and the reference U explain the "attributes" discussed by Phillippe (and indeed, Applicant submits they are not for the reasons espoused above), Applicant submits that the cited portions of the '258 patent and/or the reference U nonetheless fail to disclose, teach, or suggest, the subject matter the Office Action alleges to be inherent in Phillippe, for the reasons discussed below.

The Office Action asserts that "Offering discounts for products sold, and therefore, having the ability to account for discounted products through some sort of coding flag was well known at the time of invention." Further, the Office Action asserts that the "Examiner

thus has construed the product question transaction (col. 7, lines 34-35) of Phillippe, et al. to include discount transactions related to the purchase of a products (sic)." Applicant disagrees with the conclusions inherent in this argument as well as the mode of analysis.

Applicant submits that the Examiner has not met his burden to show that a discount is inherently disclosed by Phillippe. *See* MPEP § 2112 IV ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art") (emphasis added). There simply has not been a clear and unmistakable showing that Phillippe (alone and/or supported by the '258 patent and/or the reference U) disclose, teach, or suggest "... discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data; and ... executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops," as recited in claim 4.

Applicant recognizes that discounts in a single shop at a web site are common practice as disclosed, for example, in the reference U for Barnes and Nobles Inc. However, discounts across a plurality of virtual shops in a virtual mall is neither mentioned nor suggested by any of these references.

Accordingly, Applicant submits that the cited portions of Phillippe do not disclose, teach, or suggest, each and every limitation of claims 4, 8 and 11. Claims 5-7, 9, 10, 12, and 13 depend from claims 4, 8 and 11 respectively and are, therefore, patentable for at least the same reasons provided above related to claims 4, 8 and 11, and for the additional features recited therein. Claims 1-3 have been canceled and thus their rejection is now moot. Thus, Applicant respectfully requests that the rejection of claims 4-13 under 35 U.S.C. §102(e) in view of Phillippe should be withdrawn and the claims be allowed.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

A. Claims 7, 10 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ikeda in view of Phillippe. Applicant traverses this rejection for at least the following reasons.

As discussed above, the cited portions of Ikeda, Phillippe, or in combination, disclose, teach, or suggest " ... discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops

thus has construed the product question transaction (col. 7, lines 34-35) of Phillippe, et al. to include discount transactions related to the purchase of a products (sic)." Applicant disagrees with the conclusions inherent in this argument as well as the mode of analysis.

Applicant submits that the Examiner has not met his burden to show that a discount is inherently disclosed by Phillippe. *See* MPEP § 2112 IV ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art") (emphasis added). There simply has not been a clear and unmistakable showing that Phillippe (alone and/or supported by the '258 patent and/or the reference U) disclose, teach, or suggest "... discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data; and ... executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops," as recited in claim 4.

Applicant recognizes that discounts in a single shop at a web site are common practice as disclosed, for example, in the reference U for Barnes and Nobles Inc. However, discounts across a plurality of virtual shops in a virtual mall is neither mentioned nor suggested by any of these references.

Accordingly, Applicant submits that the cited portions of Phillippe do not disclose, teach, or suggest, each and every limitation of claims 4, 8 and 11. Claims 5-7, 9, 10, 12, and 13 depend from claims 4, 8 and 11 respectively and are, therefore, patentable for at least the same reasons provided above related to claims 4, 8 and 11, and for the additional features recited therein. Claims 1-3 have been canceled and thus their rejection is now moot. Thus, Applicant respectfully requests that the rejection of claims 4-13 under 35 U.S.C. §102(e) in view of Phillippe should be withdrawn and the claims be allowed.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

A. Claims 7, 10 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ikeda in view of Phillippe. Applicant traverses this rejection for at least the following reasons.

As discussed above, the cited portions of Ikeda, Phillippe, or in combination, disclose, teach, or suggest " ... discriminating whether items indicated by at least two discount item flags in a plurality of purchased item data are respectively purchased from different shops

based on the purchased item data; and ... executing a discount if the discriminating means determines that the items indicated by the at least two discount item flags are purchased from different shops, as recited in claim 4. Claims 8 and 11 recite similar limitations as claim 4, respectively and thus, the analysis applies equally.

Claims 7, 10 and 13 depend respectively from claims 4, 8 and 11, and are, therefore, patentable for at least the same reasons provided above related to claims 4, 8 and 11, and for the additional features recited therein. Thus, Applicant respectfully requests that the rejection of claims 7, 10 and 13 under 35 U.S.C. §103(a) in view of Ikeda further in view of Phillippe should be withdrawn and the claims be allowed.

III. CONCLUSION

All rejections have been addressed. It is respectfully submitted that the present application is in a condition for allowance, and a notice to that effect is earnestly solicited. Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

ERIC BRETT COMPTON
Reg. No. 54,806
Tel. No. 703.770.7721
Fax No. 703.770.7901

Date: February 23, 2007
P.O. Box 10500
McLean, VA 22102
(703) 770-7900